

AMENDMENT AND RESPONSE

Applicant: Mark L. Yoseloff

Serial No.: 09/405,921

Filed September 24, 1999

Title: VIDEO GAMING APPARATUS FOR WAGERING WITH

UNIVERSAL COMPUTERIZED CONTROLLER AND I/O INTERFACE FOR UNIQUE ARCHITECTURE

Docket No.: 307.026US1 PA0368.ap.US

Examiner: S. Ashburn

Group Art Unit: 3713

Claims Rejections Under 35 U.S.C. 112, First Paragraph

Claim 18 is rejected under 35 U.S.C. 112, first paragraph as lacking enablement. It is asserted that the I/O adapter is insufficiently described to enable its manufacture and use without undue experimentation. The previous basis of a rejection that Applicant must provide greater detail as to the best mode application of the invention has been dropped in this rejection. It is also asserted that Applicant must clarify what is unique about the I/O component in comparison with the known I/O interfaces.

Rejections Under 35 U.S.C. 103(a)

Claims 1-26 have been rejected under 35 U.S.C. 103(a) as unpatentable over Acres (U.S. Patent No. 5,752,882) in view of Arcade Machine Retrofit (10/20/1996, www.cygnus.uwa.edu.aujaycole/jaw/arcade.html, hereinafter referred to as "Arcade").

EXAMINER'S RESPONSE TO THE ARGUMENTS OF APPLICANTS**Rejection of Claim 18 Under 35 U.S.C. 112, First Paragraph**

The position taken by the Office Action is that

"(D)espite its complexity, the interface adapter is only superficially described in the specification. Overall, the specification demonstrates the applicant's conception of the problem to be solved; however it does not offer an enabled solution. To the examiner's knowledge, no 'off the shelf' single unit has the capacity to perform the functions described in the specification... It would be an utterly non-trivial engineering effort to construct and/or configure such a device."

This assertion of lack of enablement is in error. The standard for 35 U.S.C. 112, first paragraph must be based upon the reasonable skill of the ordinary artisan in the art most closely related to the invention as claimed. The consideration of this issue must also be based upon an analysis of the actual requirements for practice and manufacture of the invention. As stated in *Northern Telecom, Inc. v. Datpoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990):